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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/616,887	07/10/2003	Hayim Lindenbaum	U 014713-7	1672
140	7590	08/24/2005	EXAMINER	
LADAS & PARRY 26 WEST 61ST STREET NEW YORK, NY 10023			VRETTAKOS, PETER J	
			ART UNIT	PAPER NUMBER
			3739	
DATE MAILED: 08/24/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/616,887

Applicant(s)

LINDENBAUM ET AL.

Examiner

Peter J. Vrettakos

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 11-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 8/3, 1/5, 2/5.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

**Claims 11-20 are elected without traverse 7-28-05. Claims 1-10 are non-elected.**

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

**Claim 13 is rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.**

The claim(s) are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The claim neglects to positively identify new structure. (Instead the claim is a characterization of the device's placement during use as depicted in Applicant's figure 2).

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application

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by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

**Claims 11-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Dubrul et al. (6,450,989).**

Dubrul discloses a hemostasis device (col. 10:54-60; see figure 2) with an anchor balloon (4), a peripheral balloon (9), electrodes (col. 18:5-18), and a radiation (analogous but not necessarily anticipatory here to RF) power source (patented claim 5).

Note: claim language regarding the effects of the electrodes (heating blood volume, coagulating blood, and closing a puncture) are toward the intended use of the device and carry no patentable weight in a device claim. In other words, sufficient anticipation is shown by the disclosure of electrodes in the prior art.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 13 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dubrul in view of Kontos (5,928,266).**

Dubrul refers RF energy in col. 1:52-56.

*Dubrul neglects to expressly disclose blood volume delimiting.* Kontos discloses a hemostasis device (analogous to Dubrul) comprising a pair of electrodes (304, figure 17, also see patented claims 1 and 3), and an RF generator (col. 6:50). Therefore, at the time of the invention it would have been obvious to one of ordinary skill in the art to modify Dubrul in view of Kontos by using Dubrul for hemostasis in a manner analogous to that in Kontos figure 9 (sealing material 78 would merely be substituted by the peripheral balloon (9) in Dubrul). The motivation to use Dubrul in this manner would be to simply choose a well-known method of hemostasis for the disclosed Dubrul device.

Note: delimiting blood volume is borderline intended use language. This was addressed in the 112 rejection above. However, because Dubrul only makes reference to hemostasis (col. 10:54-60) once, Kontos is presented, which depicts in figure 9 a hemostasis device with an anchor balloon (20) and sealing material (78 – analogous to a “peripheral” balloon). Further, Kontos depicts *a pair of electrodes* (304, figure 17), whereas Dubrul refers to “electrodes” (col. 18:5-18), but does not refer to multiple electrodes on a single embodiment. (The Dubrul disclosure of “electrodes” instead is only with reference to multiple speculated embodiments).

**Claims 14-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dubrul in view of Kontos and further in view of Woltosz (4,211,230).**

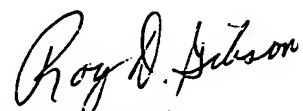
Dubrul and Kontos neglect to disclose feedback control during hemostasis. Woltosz discloses an electrosurgical device (generic term) and a corresponding hemostatic method including radiofrequency electrodes, feedback control, and parameters making obvious the Applicant's claims. Therefore, at the time of the invention it would have been obvious to one of ordinary skill in the art to modify Dubrul in view of Kontos and further in view of Woltosz by integrating the Woltosz feedback controller as well as disclosed parameters, into the Dubrul/Kontos device and method, respectively. The motivation to use Woltosz in this manner would be to simply choose a well-known design expedient and hemostasis parameters for the speculated Dubrul/Kontos device.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter J. Vrettakos whose telephone number is 571-272-4775. The examiner can normally be reached on M-F 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. Dvorak can be reached on 571-272-4764. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pete Vrettakos  
August 5, 2005



ROY D. GIBSON  
PRIMARY EXAMINER